

Appln. No. 09/506,434
Response to Final Rejection dated February 28, 2005
Amendment after Final Rejection dated April 26, 2005

REMARKS

Applicants hereby file this Amendment after Final Rejection in response to the Final Rejection mailed on February 28, 2005. Claims 60-67 have been added. Claims 1, 4, 10, 11, 13, 15, 17, 21 and 50-67 are pending. The specification has been objected to because the figure descriptions in the specification are allegedly not in agreement with the drawing labels in the figures. See Final Rejection at ¶ 4. Further, the specification has been objected to because the references to "data" and "information" are allegedly not consistent. See Final Rejection at ¶ 4. Claims 1, 4, 10, 11, 13, 50-54 and 56 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 5,819,236 to Josephson ("Josephson") in view of U.S. Patent No. 5,751,842 to Riach et. al. ("Riach"). See Final Rejection at ¶ 6. Claims 15, 17, 55 and 59 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Josephson in view of U.S. Patent No. 5,933,816 to Zeanah et. al. ("Zeanah"). See Final Rejection at ¶ 7. Claims 21, 57 and 58 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Josephson in view of U.S. Patent No. 6,012,048 to Gustin et. al. ("Gustin"). See Final Rejection at ¶ 8. The previous rejection of claim 15 under 35 U.S.C. § 112, second paragraph has been withdrawn, for which Applicants thank the Examiner. See Final Rejection at ¶ 3.

Applicants thank the Examiner for the telephonic interview held on April 6, 2005. This Amendment After Final Rejection is being filed commensurate with that interview.

I. Objections to the Specification.

The specification has been objected to because the figure descriptions in the specification are allegedly not in agreement with the drawing labels in the figures. See Final Rejection at ¶ 4. The Examiner states that Fig. 2 in the Specification references "enter requested information 230"; "missing information 240"; and "submit transaction to BOFD for processing 250", while the drawing labels for Fig. 2 are "ENTER REQUESTED DATA 230"; "SUBMIT TRANSACTION TO BOFD SYSTEM FOR PROCESSING 250." Applicants cannot locate in the Specification the phrase "enter requested information 230" and request that the Examiner point to this section so it can be amended if necessary. In the Amendment and Response filed on December 8, 2004, Applicants amended the Specification with respect to element 240 of Fig. 2

to reference "missing data 240" rather than "missing information 240." See Amendment and Response of December 8, 2004 at p. 2. Applicants are unclear as to the objection that the description of element 250 in the Specification differs from that in Fig. 2. Applicants request that the Examiner provide further explanation of the objection so amendments can be made if necessary.

Fig. 3 in the Specification references "security function 305"; "terminate process 310"; "receive transaction 315"; "make decision 345"; and "format ECP transaction 360", while the drawing labels reference "SECURITY FUNCTION FOR AUTHORIZED USER 305"; "TERMINATE PROCESS FOR UNAUTHORIZED USER 310"; "RECEIVE TRANSACTION DATA FOR CHECK DEPOSIT 315"; "Determine Method for Clearing Check 345"; and "Format Transaction for ECP 360." The Specification has been amended to conform with the labels in Fig. 3 and respectfully request that this objection be withdrawn.

Further, the Specification has been objected to because the references to "data" and "information" allegedly are not consistent. See Final Rejection at ¶ 4. The original Specification as filed has been searched electronically and all located references to the term "information" were previously amended in the Amendment and Response of December 8, 2004 to read "data." Applicants cannot locate further instances of references to "information" that have not been amended, and kindly request that the Examiner provide further explanation so that amendments can be made if necessary.

II. Rejections under 35 U.S.C. § 103(a).

A. Rejection of claims 1, 4, 10, 11, 13, 50-54 and 56 over Josephson in view of Riach.

Claims 1, 4, 10, 11, 13, 50-54 and 56 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Josephson in view of Riach. Applicants respectfully submit that this rejection should be withdrawn because the cited references in combination do not teach each and every element of the claimed inventions of claims 1, 4, 10, 11, 13, 50-54 and 56, as amended, and therefore do not form a *prima facie* case of obviousness.

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It is stated that Josephson in combination with Riach teaches each and every element of claim 1. *See* Final Rejection at ¶ 6. As discussed in the telephonic interview on April 6, 2005, the invention of claim 1 relates to a system for depositing the value associated with conventional checks into the bank account of a customer payee. The invention of claim 1 allows a customer payee to deposit the discrete value of a conventional check from his or her home, without physical receipt of the check by the automated banking system. *See* Specification at p. 4, lines 4-15. An action may be taken to prevent re-deposit of the same check, such as marking each conventional check by human or machine readable ink, physical capture of each conventional check or combinations thereof. *See* Specification, p. 8, line 19 to p. 9, line 2; new claims 60, 61.

In contrast, both Josephson and Riach disclose systems that permit conventional checks to be deposited in manners known in the prior art - *i.e.*, methods requiring physical receipt of the check by the system. For example, Josephson discloses an electronic system and method for providing advance notification of a potential return that may occur when a presenting financial institution ("FI") eventually presents an item for payment to a paying FI in a subsequent paper-based presentment process. *See* Abstract. The invention addresses deficiencies of the prior art, for example the delay that occurs between the time is deposited at a sending FI and the time the paying FI pays the money to the sending FI. *See* col. 2, lines 28-33. During this delay, the sending FI must either place a hold on the check depositor's account for the amount of the check, or else incur the risk that the paying FI will reject the check. *See* col. 2, lines 31-36. However, federal law imposes time limits on the length of time a sending FI can retain a hold on depositor's funds. *See* col. 2, lines 40-45. The invention addresses these deficiencies by maintaining a database of restricted account data. *See* col. 4, lines 24-27. When a sending FI captures item data from an item, such as a deposited check, the item data are checked against the restricted account data to determine whether the item is drawn on an account that the paying FI has restricted. *See* col. 4, lines 27-31.

The only disclosure in Josephson regarding methods and sources of deposits of a conventional check are those currently used in a "conventional, paper-based presentment process . . . beginning with a deposit of items by a depositor with the sending FI." *See* col. 7, line 66 to

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col. 8, line 2. These deposited items “are received from a variety of sources (for example, over-the-counter, drive-in depositories, automated teller machines (‘ATMs’), mail or lockboxes.” See col. 8, lines 2-7. Josephson discloses methods for capturing item data from items received by the sending FI from its depositors, which include use of MICR (magnetic ink detection circuitry) technology; machine vision; or manually. See col. 4, lines 46-55. All methods of capturing item data in Josephson entail physical receipt of the item itself, and there is no disclosure otherwise. Thus, Josephson does not disclose a system whereby an automated banking system and a check clearing system are configured to effectuate deposit of the discrete value of a conventional check into an account of a customer payee without physical receipt of the conventional check by the automated banking system, as claimed in claim 1.

Similarly, Riach discloses a document transaction apparatus that accepts from a user a document to be processed for a financial transaction such as depositing a check or paying a bill. See Abstract; col. 1, lines 40-43; col. 2, lines 30-31; col. 3, line 37; col. 4, lines 5-7. Riach does not disclose a system whereby an automated banking system and a check clearing system are configured to effectuate deposit of the discrete value of a conventional check into an account of a customer payee without physical receipt of the conventional check by the automated banking system, as claimed in claim 1.

Since at least this limitation is not disclosed in a combination of Josephson and Riach, this combination of references does not form a *prima facie* case of obviousness of the invention of claim 1. Accordingly, Applicants respectfully request that the rejection of claim 1, and dependent claims 4, 10, 11, 13, over Josephson in view of Riach be withdrawn.

Further, neither Josephson nor Riach disclose each and every element of claim 50. Applicants respectfully submit that neither Josephson nor Riach disclose a system whereby an automated banking system and a check clearing system are configured to effectuate deposit of the discrete value of a check into a demand deposit account of a customer payee without physical receipt of the check by the automated banking system, as claimed in claim 50. Therefore, each and every limitation of claim 50 is not disclosed by Josephson and Riach in combination, and a *prima facie* case of obviousness has not been set forth based on these references. Accordingly,

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Applicants respectfully request that the rejection of claim 50, and dependent claims 51-53 and 56, over Josephson in view of Riach be withdrawn.

B. Rejection of claims 15, 17, 55 and 59 over Josephson in view of Zeanah.

Claims 15, 17, 55 and 59 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Josephson in view of Zeanah. Applicants respectfully submit that this rejection should be withdrawn because the cited references in combination do not teach each and every element of the claimed inventions of claims 15, 17, 55 and 59 and therefore do not form a *prima facie* case of obviousness.

It is stated that it would have been obvious to modify Josephson in view of Zeanah to render the invention of claim 15 obvious. *See* Final Rejection at ¶ 7. Applicants respectfully submit that Josephson in combination with Zeanah does not disclose each and every limitation of claim 15. Applicants previously described Josephson in Sec. II(B). There is no disclosure in Josephson of a computerized method whereby the discrete value of a check for deposit is processed by an automated banking system without physical receipt of the conventional check by the automated banking system, as claimed in claim 15.

Zeanah discloses a delivery system and method that allows a financial institution to provide financial services to a plurality of remote devices, such as personal computers, personal data assistants and screen phones. *See* Abstract. The invention of Zeanah is a single base for interfacing with all types of remote devices, allowing bank customers to access banks from a variety of remote devices or from other countries while reducing the complexity required of the bank's internal computer system. *See* col. 2, line 4- col. 3, line 23; col. 3, lines 39-48. Also, the Zeanah system and method reduces the amount of testing that is required for modifications to the applications that govern the bank's internal computer system. *See* col. 3, lines 24-48. Zeanah discloses an interface between a bank and a customer's personal computer for performing transactions from a customer's home that are known in the art, such as bill paying and money transfers. *See* col. 1, lines 58-63. However, Zeanah does not disclose deposits of conventional checks at all, much less a computerized method whereby the discrete value of a check for deposit is processed by an automated banking system without physical receipt of the conventional check

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by the automated banking system. Therefore, a combination of Josephson and Zeanah does not disclose the invention of claim 15 and Applicants respectfully request that the rejection of claim 15, and dependent claim 17, under 35 U.S.C. § 103 over Josephson in view of Zeanah be withdrawn.

For the same reasons stated above, Applicants also submit that Josephson in combination with Zeanah does not disclose each and every limitation of claims 55 and 59. Specifically, neither Josephson nor Zeanah, alone or in combination, discloses a computerized method whereby the discrete value of a check is processed for deposit by an automated banking system from a customer terminal into an associated demand deposit account without physical receipt of the check by the automated banking system (claim 55) or a computerized method whereby a transaction for the deposit of the discrete value of a check is processed without physical receipt of the conventional check by an automated banking system (claim 59). Accordingly, Applicants respectfully request that the rejection of claims 55 and 59 under 35 U.S.C. § 103 over Josephson in view of Zeanah be withdrawn.

C. Rejection of claims 21, 57 and 58 over Josephson in view of Gustin.

Claims 21, 57 and 58 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Josephson in view of Gustin. Applicants respectfully submit that this rejection should be withdrawn because the cited references in combination do not teach each and every element of the claimed inventions of claims 21, 57 and 58 and therefore do not form a *prima facie* case of obviousness.

It is stated that it would have been obvious to modify Josephson in view of Gustin to render the invention of claims 21, 57 and 58 obvious. See Final Rejection at ¶ 8. Applicants respectfully submit that Josephson in combination with Gustin does not disclose each and every limitation of claims 21, 57 and 58. Applicants previously described the Josephson disclosure in Sec. II(B). Applicants respectfully submit that, for the reasons stated previously in Sec. II(B), Josephson does not disclose or teach a computerized method whereby a transaction for the deposit of the discrete value of a check is processed without physical receipt of the conventional check by an automated banking system as claimed in claim 21.

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Gustin discloses an automated banking system for wire transfer of funds with a machine where a user has a card to identify the user as being qualified to use the banking system. *See* Abstract. The machine is preferably an ATM machine. *See id.* The user may pay for the wire transfer at the ATM. *See id.* The ATM, in addition to performing its usual functions, additionally issues money orders without the presence or assistance of a teller, and may also allow the depositing of cash into the machine and the transferring of money by wire, paying bills or purchasing end user items such as lottery tickets or postage stamps. *See* col. 4, lines 1-18. Gustin does not, however, disclose the limitations not disclosed by Josephson of a computerized method whereby a transaction for the deposit of the discrete value of a check is processed without physical receipt of the conventional check by an automated banking system. Rather, Gustin discloses depositing a check into an ATM. *See* col. 12, lines 3-47. The check is inserted into the ATM and the transaction data from the check is detected by a MICR reader. *See id.*; col. 19, line 56- col. 20, line 63. Further, the transaction data that is received in Gustin is *not* received from a bank customer using a terminal that is remotely situated from the bank and the automated banking system, as required in claim 21, but rather is read from the check by a MICR reader located in an ATM. Applicants respectfully submit that the combination of Josephson and Gustin does not disclose each and every limitation of claim 21, and therefore does not form a *prima facie* case of obviousness, and request that this rejection be withdrawn.

For the same reasons discussed above, Josephson in combination with Gustin also does not disclose each and every limitation of claims 57 and 58. As discussed in Sec. II(B), Josephson does not disclose each and every limitation of claim 55 from which claims 57 and 58 depend. Neither does Gustin disclose a computerized method whereby the discrete value of a check is processed for deposit by an automated banking system without physical receipt of the check by the automated banking system as claimed in claim 55. Rather, Gustin discloses depositing a check into an ATM. *See* col. 12, lines 3-47. The check is inserted into the ATM and the transaction data from the check is detected by a MICR reader. *See id.*; col. 19, line 56- col. 20, line 63. Applicants respectfully submit that the combination of Josephson and Gustin

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does not disclose each and every limitation of claim 55 and therefore does not form a *prima facie* case of obviousness of claims 57 and 58, and request that this rejection be withdrawn.

D. New Claims 60-67

Since new claims 60-67 are dependent on claims 1, 50, 55 or 59, and none of the independent claims are obvious in view of any of the cited references, Applicants further submit that claims 60-67 are also allowable over the cited prior art.

CONCLUSION

Based on this background, Applicants respectfully submit that claims 1, 4, 10, 11, 13, 15, 17, 21, and 50-67 are in condition for allowance and request allowance of the same.

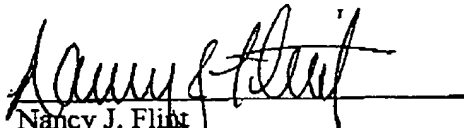
Applicants believe that no fee is due upon the filing of this Amendment After Final Rejection which has been filed within two (2) months of the date of mailing of the Final Rejection. If any fees are determined to be due, the Commissioner is hereby authorized to deduct such fees from the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

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